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DATE: March 11, 2005
TO: Patrick Ryan
FAX NUMBER: (703) 872-9306
RE: Serial No. 09/930,539
Docket: 7310.C

TOTAL NUMBER OF PAGES INCLUDING COVER SHEET: 22

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:	
RODNEY M. LAFOLLETTE, ET AL.	Docket: 7310.C
Serial No.: 09/930,539	Art Unit: 1745
Filed: August 14, 2001	Examiner: Raymond Alejandro
For: MICROSCOPIC BATTERIES FOR MEMS SYSTEMS	

RESPONSE TO NOTIFICATION OF NON-COMPLIANT APPEAL BRIEF

Patrick Ryan
Director - Group 1740
Commissioner for Patents
P.O. Box 1450
Arlington, VA 22313-1450

Sir:

This is in response to the erroneous Notification of Non-Compliant Appeal Brief (Notification), copy appended as Attachment C and invokes the authority of the Director of Patent Examining Group 1740.

The Notification, while citing to 37 CFR § 1.191(a) and MPEP 1205, draws clearly erroneous conclusions, i.e.:

1. The appealed claims having identical substance must be twice rejected and, therefore, if a claim is amended after a second rejection, an appeal as to that claim is not timely.
2. That certain claims have not been entered prior to the Notice of Appeal when they have or should have been entered.
3. The Appeal Brief unfairly appeals subject matter never examined.
4. That the Applicant must cancel limitation or language added by amendment and thereby return the appealed claims to their state prior to the amendment or withdraw the appeal.

The Group 1740 Director is respectfully requested to correct the errors of the Examiner, pointed out above, and to take certain additional action identified below.

First, the Director is requested to cause any non-entered amendments to be entered. Second, if there are further procedural requirements for such entry, the undersigned should be immediately notified.

Third, the Director is requested to bring this case of Ex parte Lemoine, 46 USPQ 2d 1420 (Bd of Pat App and Interf. 1998) to the attention of the Examiner. A copy of this case is attached as Attachment B. Lemoine unequivocally rejects the erroneous appealability positions of the Examiner, holding that it is not the exact limitations of appealed claims nor whether the claims have been rejected in the case placed on appeal that determine appealability.

The Board in Lemoine, at 1422-1423, specifically held:

Section 134 of Title 35 gives applicants the statutory right to an administrative appeal. The section provides:

An applicant for a patent, any of whose claims have
been twice rejected, may appeal from the decision
of the primary examiner to the Board of Patent
Appeals and Interferences

Jurisdiction for this appeal depends on whether appellant is an applicant "any of whose claims has been twice rejected." We conclude that appellant had the right to appeal the rejections and we have jurisdiction.

To reach a decision requires us to construe the word "claims" as used in § 34 [sic, §134]. The word is susceptible to at least two interpretations. It can refer to the claims of an application, *i.e.*, the "one or more claims particularly pointing out and distinctly claiming the subject matter" of the invention required by 35 U.S. C. § 112, ¶ 2. Or the word can be used in a more general sense to refer to claims "for a patent" as it is used in 35 U.S.C. § 132. In this latter sense, the word is synonymous with a request or demand for a patent.

* * * *

. . . we conclude that the "claims" as used in § 134 is a reference to the repeated "claim for a patent" as used in § 132 rather than a reference to a particular claim "of an application." Under our interpretation, *so long as the applicant has twice been denied a patent, an appeal may be filed*. So construing the statute,

we conclude that applicant's claims for a patent have been twice rejected. Applicant has been denied a patent three times. Applicant, therefore, had the right to appeal and we, accordingly, have jurisdiction. (Emphasis added).

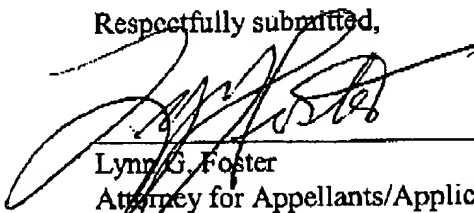
We must now determine whether the Applicants here have been "twice . . . denied a patent," independent of the number of patent applications. To this end, reference is made to appended Attachment A, where, in respect to this application, it can be seen that the Applicants have been "denied a patent," four times, i.e., three times in parent SN 09/037,801, and once in this application.

It follows that the Examiner's contentions in the Notification are clearly in error and that this application is correctly on appeal and the jurisdiction of the Board has been properly invoked.

The Director is courteously requested to reverse the position of the Examiner, enter any unentered amendments, recognize that the jurisdiction of the Board has been timely and properly invoked and instruct the Examiner to file an Answer in the pending Appeal of this Application. The Appeal is proper under Lemoine.

Thank you for your assistance.

Respectfully submitted,



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